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32836 7590 08/13/2012 GUERIN & RODRIGUEZ, LLP 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752			EXAMINER SALTARELLI, DOMINIC D	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GAD LIWERANT, CHRISTOPHER DODGE,
and GUILLAUME BOISSIERE

Appeal 2010-009285
Application 09/631,583
Technology Center 2400

Before JOHN A. JEFFERY, BRUCE R. WINSOR, and JOHN A. EVANS,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-12 and 36-40. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention shares streaming video with attached advertisements over a network. *See generally* Spec. 1-8. Claim 1 is illustrative with key disputed limitations emphasized:

1. A method of sending a video segment and an associated advertisement over a computer network, comprising:
 - (a) acquiring a video segment and a still image in the form of a thumbnail from a sender at a computer system;
 - (b) acquiring one or more advertisements from one or more advertisers at the computer system;
 - (c) offering to the sender an opportunity to indicate a selection of an advertisement of the one or more advertisements to be associated with the video segment;
 - (d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment; and
 - (e) directly in response to the indication accepted in step (d), automatically at the computer system:
 - (i) *assuring that the video segment is in a streaming video format;*
 - (ii) creating an identifier for the video segment, wherein the identifier includes the still image and a link to the video;
 - (iii) associating the video segment and the advertisement; and
 - (iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer.

THE REJECTIONS

1. The Examiner rejected claims 1-6 and 36-40 under 35 U.S.C. § 103(a) as unpatentable over Rothschild (US 2001/0047294 A1; Nov. 29,

2001 (eff. filed Jan. 6, 2000)),¹ the “Streaming Email” publication (Non-Patent Document XP-002150023, *Streaming Email*, ch. 18, pp. 303-17 (Sept. 1998)), and Sezan (US 6,236,395 B1; May 22, 2001 (filed Apr. 26, 1999)). Supp. Ans. 6-12.²

2. The Examiner rejected claims 7-11 under 35 U.S.C. § 103(a) as unpatentable over Rothschild, the “Streaming Email” publication, Ellis (US 6,774,926 B1; Aug. 10, 2004 (eff. filed Sept. 3, 1999)), and Sezan. Supp. Ans. 1-5.

3. The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as unpatentable over Rothschild, Ellis, the “Streaming Email” publication, Sezan, and Eldering (US 6,820,277 B1; Nov. 16, 2004 (prov. appl’n 60/130,102 filed Apr. 20, 1999)). Supp. Ans. 5.

THE OBVIOUSNESS REJECTION OVER ROTHSCHILD, THE
“STREAMING EMAIL” PUBLICATION, AND SEZAN

The Examiner finds that Rothschild’s method of sending a video segment and associated advertisement has every recited feature of representative claim except for (1) automatically performing step (e)’s four recited substeps responsive to the indication accepted in step (d), and (2)

¹ Although Appellants’ provisional application 60/147,029 was filed on August 3, 1999, which is earlier than Rothschild’s earliest effective filing date (Jan. 6, 2000) (and Ellis cited below), Appellants do not dispute these references qualifying as prior art.

² Throughout this opinion, we refer to (1) the Appeal Brief filed October 30, 2009; (2) the Examiner’s Answer mailed January 4, 2010; and (3) the Supplemental Answer mailed February 24, 2010 (“Supp. Ans.”). Since the Supplemental Answer restates the Examiner’s grounds of rejection in their entirety, we therefore refer to the Supplemental Answer for the grounds of rejection.

acquiring a still thumbnail image that is included in a video segment identifier. Supp. Ans. 6-8. The Examiner, however, cites the “Streaming Email” publication and Sezan for teaching features (1) and (2) respectively in concluding that the claim would have been obvious. *Id.*

Appellants argue that not only does the cited prior art not assure that video segments are in a streaming video format as claimed, the “Streaming Email” publication teaches away from its proposed combination with Rothschild (and the claimed invention) since the “Streaming Email” publication is said to require a specialized player to view streamed video. Br. 4-7. Appellants add that it would have not been obvious to provide Sezan’s thumbnail images in the context of email communications as recited in claim 36. Br. 7-8.

ISSUES

(1) Under § 103, has the Examiner erred in rejecting claim 1 by finding that Rothschild, the “Streaming Email” publication, and Sezan collectively would have taught or suggested assuring that video segments are in a streaming video format?

(2) Is the Examiner’s reason to combine the teachings of these references supported by articulated reasoning with some rational underpinning to justify the Examiner’s obviousness conclusion? This issue turns on whether the cited references teach away from their proposed combination.

ANALYSIS

We begin by noting that the Examiner's findings regarding the respective disclosures of Rothschild, the "Streaming Email" publication, and Sezan as they pertain to the recited limitations of representative claim 1 are undisputed except with respect to *assuring* that video segments are in a streaming video format. *See* Br. 4-8. But we see no error in the Examiner's position (Ans. 8) that the "Streaming Email" publication's "Video Express" server assures this streaming format by compressing video files for streaming. Ans. 8 (citing the "Streaming Email" publication at 311). As the Examiner indicates, compressing files for streaming is distinct from downloading uncompressed video files—a selectable non-streaming option for viewing higher quality files. *See* the "Streaming Email" publication at 312. In short, the server's compressing files for streaming assures that they are in a compressed streaming video format. We therefore are unpersuaded of error in the Examiner's position regarding the recited streaming format assurance in claim 1 and the server's similar confirmation in claim 36.

Nor are we persuaded that the references teach away from their proposed combination as Appellants contend. Br. 5-8. To be sure, recipients of video email messages in the "Streaming Email" publication must have the appropriate player to view the video. The "Streaming Email" publication at 311 (step 5). But leaving aside the fact that this player need not be attached to the message, but rather can be separately downloaded (*id.*; Ans. 9), merely requiring a certain player to view streamed video does not teach away from providing such a feature in Rothschild, let alone teach away from the claimed invention which does not preclude requiring such a player as the Examiner indicates. Ans. 8-9.

Nevertheless, even assuming, without deciding, that recipients of Rothschild's video transmission do not need a *proprietary* player to view received video as Appellants contend (Br. 6) (despite requiring *some* player to view received video), requiring a certain player to view streamed video hardly teaches away from providing that video in Rothschild as the Examiner proposes. Rather, this enhancement merely predictably uses prior art elements according to their established functions—an obvious improvement. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

And even assuming, without deciding, that a system requiring a proprietary player is less desirable than one not requiring that player, that alone is insufficient to teach away from the less-desirable alternative unless the cited prior art criticizes, discredits, or otherwise discourages that alternative—which it does not. *See In re Fulton*, 391 F.3d 1195, 1200-01 (Fed. Cir. 2004). In any event, the disadvantages of requiring a special player to view streamed video could very well be offset by the advantages of streamed video in terms of speed and convenience—a tradeoff well within the level of ordinarily skilled artisans.

Lastly, we see no error in the Examiner's position that it would have been obvious to provide thumbnail images as suggested by Sezan to indicate the content of an associated video file. Ans. 9-10. Appellants' contention that this feature would have been unnecessary at the time of the invention since video attachments would be discouraged due to limited broadband connectivity (Br. 7-8) is not only speculative, but is undercut by the Examiner's point that email messages need not have any video attachments at all, but rather can contain pointers to corresponding files. Ans. 9-10. In any event, enhancing the disclosed video transmission system with

thumbnail images as taught by Sezan merely predictably uses prior art elements according to their established functions—an obvious improvement. *See KSR*, 550 U.S. at 417.

THE OTHER OBVIOUSNESS REJECTIONS

Appellants present no arguments pertaining to the Examiner’s obviousness rejections of claims 7-12, Supp. Ans. 1-5. *See* Br. 4 (omitting these rejections from the Brief’s “Grounds of Rejection to be Reviewed on Appeal” section). *Accord* Br. 2 (“Only independent claims 1 and 36 are the subject of this Appeal.”). Accordingly, we summarily sustain these rejections. *See* MPEP § 1205.02 (8th ed., rev. 8, July 2010) (“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, that ground of rejection will be summarily sustained by the Board.”).

CONCLUSION

The Examiner did not err in rejecting claims 1-12 and 36-40 under § 103.

ORDER

The Examiner’s decision rejecting claims 1-12 and 36-40 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

babc